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10/786,102	02/26/2004	Keisuke Horigami	03-52273	2489

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EXAMINER
STRODER, CARRIE A

ART UNIT	PAPER NUMBER
3689	

NOTIFICATION DATE	DELIVERY MODE
08/19/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>21 June 2010</u>.

2a) ☒ This action is FINAL.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>14-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>21 June 2010</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This is in response to the applicant's communication filed

on 21 June 2010, wherein:

    Claims 14-21 are currently pending;

    claims 14-21 are new; and

    claims 1-13 are cancelled.

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35

U.S.C. 112:

> The specification shall conclude with one or more claims particularly
> pointing out and distinctly claiming the subject matter which the applicant
> regards as his invention.

2.   **Claims 14-19 are rejected under 35 U.S.C. 112, second**

paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicant

regards as the invention.

    Claims 14-19 claim to be an apparatus; however, no

structure is described. For example, claim 14 refers to various

"units"; however, what the structure of these units are, is

unclear. Examples of structure include a processor, a display

device, and a keyboard. Only structural aspects of an apparatus

claim receive patentable weight; however, to expedite

prosecution, Examiner has given weight to the claimed

functionality for the art rejections, below.

Further, the language of claims 14 and 16-17 is confusing. For example, claim 14 states, in the third limitation, "a proper registration propriety decision unit that refers the product information registration unit by using the acquired product information…" but it is unclear how the registration propriety decision unit uses the acquired product information and grammatically, it seems this should read, "a proper registration propriety decision unit that refers _**to**_ the product information registration unit by using the acquired product information…"

Claim 16 similarly states, "the temporary registration unit refers the temporary registration condition storage unit by using the product ID..." Again, it is unclear how the product ID is being used and it seems that this statement should read, "the temporary registration unit refers _**to**_ the temporary registration condition storage unit by using the product ID..." Claim 16 also states, "…and temporary registers the acquired product information decided as improper…" It is unclear whether this should be "…and _**temporarily**_ registers the acquired product information decided as improper…" or if applicant is intending to refer to the temporary registration unit.

Claim 17 states, "the temporary registration condition storage unit stores temporary registration condition…" and it is unclear if this should be _**a**_ temporary registration condition, or

if applicant is referring to a previous condition.   Claim 17

also seems like the second limitation should read, "the

temporary registration unit refers _to_ the temporary registration

condition stored in the temporary registration condition storage

unit by using a product ID included in a product information

decided as improper to be registered to the product information

registration unit, and decides _that_ the improper product

information _is_ to be registered to the temporary registration

unit when the product ID included in the improper product

information is decided to be properly registered to the

temporary registration unit" and where it is unclear how the

product ID is being used, and whether the product ID is included

in the previously referred to product information, or in some

other product information.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine,
> manufacture, or composition of matter, or any new and useful improvement
> thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claim 20 is rejected under 35 U.S.C. § 101 because the

claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under

§101, a claimed process must either: (1) tied to a particular

machine or apparatus, or (2) transforms a particular article to

a different state or thing. This is called the "machine or-transformation test". In re Bilski, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

With respect to claim 20, the claim language does not include the required tie to a particular machine or apparatus or transformation and thus is directed to nonstatutory subject matter. Claim 20 refers to a "product information registration unit" which may be software, or some other, unknown item.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs

of 35 U.S.C. 102 that form the basis for the rejections under

this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in
> this or a foreign country or in public use or on sale in this country, more
> than one year prior to the date of application for patent in the United
> States.

2.   **Claims 14, 16-17, and 20-21 are rejected under 35**

U.S.C. 102(b) as being anticipated by Highbloom (US 5623403).

Referring to claim 14:

Highbloom discloses

a product information acquisition unit that acquires

product information including a product ID (identification)

identifying a product to be registered (col. 7, lines 35-55;

"…comparing the VIN against a prestored range of valid VIN

numbers provided by the manufacturers" where it is inherent that

the VIN is acquired and where a VIN is interpreted as a product

ID);

a product information registration unit that registers

product information of a shipped product (col. 7, lines 35-55;

"…comparing the VIN against a prestored range of valid VIN

numbers provided by the manufacturers" where the "prestored

range of valid VIN numbers" is interpreted as a product

information registration unit) ;

a proper registration propriety decision unit that refers

the product information registration unit by using the acquired

product information, and decides whether or not the acquired

product information is to be properly registered in the product

information registration unit based on whether or not the

acquired product information is registered in the product

information registration unit (col. 7, lines 35-55; "An optional

third step may be performed which includes comparing the VIN

against a prestored range of valid VIN numbers provided by the

manufacturers. If the VIN passes all of the provided steps, the

record 38 or 40 is entered into the memory 26 of the monitoring

computer 12 for subsequent data comparisons by the data

comparator 28.");

a temporary registration condition storage unit that stores

temporary registration condition information providing a

condition permitting temporary registration of product

information (col. 7, lines 35-55; "If the error cannot be

corrected, the record may still be entered into the memory 26

but is flagged for error reporting and is not processed by the

data comparator 28."); and

a temporary registration unit that temporarily registers
the acquired product information when the acquired product
information is decided as improper to be registered in the
product information registration unit by the proper registration
propriety decision unit and when the acquired product
information meets the temporary registration condition
information (col. 7, lines 35-55; "If the error cannot be
corrected, the record may still be entered into the memory 26
but is flagged for error reporting and is not processed by the
data comparator 28.").

Referring to claim 16:

Highbloom discloses

wherein the temporary registration condition information
includes at least a product ID identifying a product (col. 7,
lines 35-55; "…comparing the VIN against a prestored range of
valid VIN numbers provided by the manufacturers" and where "VIN"
is interpreted as a product ID), and

the temporary registration unit refers the temporary
registration condition storage unit by using the product ID
included in the acquired product information decided as improper
to be registered in the product information registration unit so
as to decide whether or not the acquired product information
decided as improper to be registered in the product information

registration unit is to be temporarily registered in the

temporary registration unit, and temporary registers the

acquired product information decided as improper to be

registered in the product information registration unit, in the

temporary registration unit when the product ID included in the

improper product information is decided to be properly

registered in the temporary registration unit (col. 7, lines 35-

55; "An optional third step may be performed which includes

comparing the VIN against a prestored range of valid VIN numbers

provided by the manufacturers. If the VIN passes all of the

provided steps, the record 38 or 40 is entered into the memory

26 of the monitoring computer 12 for subsequent data comparisons

by the data comparator 28." and "If the error cannot be

corrected, the record may still be entered into the memory 26

but is flagged for error reporting and is not processed by the

data comparator 28.").

     Referring to claim 17:

     Highbloom discloses

     wherein the temporary registration condition storage unit

stores temporary registration condition corresponding to a

product ID (col. 7, lines 35-55; "An optional third step may be

performed which includes comparing the VIN against a prestored

range of valid VIN numbers provided by the manufacturers. If the

VIN passes all of the provided steps, the record 38 or 40 is
entered into the memory 26 of the monitoring computer 12 for
subsequent data comparisons by the data comparator 28."), and

the temporary registration unit refers the temporary
registration condition stored in the temporary registration
condition storage unit by using a product ID included in a
product information decided as improper to be registered to the
product information registration unit, and decides the improper
product information to be registered to the temporary
registration unit when the product ID included in the improper
product information is decided to be properly registered to the
temporary registration unit (col. 7, lines 35-55; "If the VIN
fails any of theses tests, the error is analyzed to determine
whether it can be corrected." and "If the error cannot be
corrected, the record may still be entered into the memory but
is flagged for error reporting and is not processed by the data
comparator.").

Referring to claims 20 and 21:

Highbloom discloses

acquiring product information including a product ID
(identification) identifying a product to be registered (col. 7,
lines 35-55; "…comparing the VIN against a prestored range of
valid VIN numbers provided by the manufacturers" where it is

inherent that the VIN is acquired and where a VIN is interpreted
as a product ID);

referring to a product information registration unit which
registers product information of a shipped product, by using the
acquired product information so as to decide whether or not the
acquired product information is to be properly registered in the
product information registration unit based on whether or not
the acquired product information is registered in the product
information registration unit (col. 7, lines 35-55; "An optional
third step may be performed which includes comparing the VIN
against a prestored range of valid VIN numbers provided by the
manufacturers. If the VIN passes all of the provided steps, the
record 38 or 40 is entered into the memory 26 of the monitoring
computer 12 for subsequent data comparisons by the data
comparator 28."); and

registering the acquired product information temporarily in
a temporary registration unit when the acquired product
information is decided as improper to be registered in the
product information registration unit by the referring and when
the acquired product information meets temporary registration
condition information providing a condition permitting temporary
registration of product information (col. 7, lines 35-55; "If
the error cannot be corrected, the record may still be entered

into the memory 26 but is flagged for error reporting and is not

processed by the data comparator 28.").

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which

forms the basis for all obviousness rejections set forth in this

Office action:

> (a) A patent may not be obtained though the invention is not identically
> disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the prior
> art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the
> art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

5.   The factual inquiries set forth in *Graham* v. *John Deere*

Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

    1.   Determining the scope and contents of the prior art.
    2.   Ascertaining the differences between the prior art and
          the claims at issue.
    3.   Resolving the level of ordinary skill in the pertinent
          art.
    4.   Considering objective evidence present in the
          application indicating obviousness or nonobviousness.

6.   **Claims 15 and 18-19 are rejected under 35 U.S.C. 103(a) as**

being unpatentable over Highbloom (US 5623403), in view of

Carey, Joan and Patrick, "Microsoft Access 2000 At a Glance"

1999 (hereinafter referred to as "Carey").

    Referring to claim 15:

Highbloom discloses using a database for monitoring
registration information, as set forth in claim 14. Highbloom
does not disclose a decision unit that decides whether a product
ID included in a product information registered in the temporary
registration unit is a product ID that is registered again in
the product information registration unit during a designated
temporary registration period or a registration migration unit
that migrates the product information from the temporary
registration unit to the product information registration unit
when the decision unit decides the product ID included in the
product information is registered again in the product
information registration unit during the designated temporary
registration period.

However, Carey teaches how to use Microsoft Access 2000, a
commonly used database. Carey teaches a decision unit that
decides whether a product ID included in a product information
registered in the temporary registration unit is a product ID
that is registered again in the product information registration
unit during a designated temporary registration period (pages 56
and 103-108; "You can specify several query fields…Access
retrieves records for which all of the criteria are satisfied…"
and "You can create a query that retrieves all the records from
the Orders table that have duplicate values for the CustomerID

field" where date and product ID may be fields in a database
table and where the name of the fields does not patentably
distinguish over the prior art), and

    a registration migration unit that migrates the product
information from the temporary registration unit to the product
information registration unit when the decision unit decides the
product ID included in the product information is registered
again in the product information registration unit during the
designated temporary registration period (pages 56, 103-108, and
110-111; "You can use a query to add records to a table by
creating an append query").

    It would have been obvious for a person of ordinary skill in
the art (PHOSITA) at the time of invention to modify the system
for using a database to monitor registration information
disclosed in Highbloom to incorporate a decision unit that
decides whether a product ID included in a product information
registered in the temporary registration unit is a product ID
that is registered again in the product information registration
unit during a designated temporary registration period and a
registration migration unit that migrates the product
information from the temporary registration unit to the product
information registration unit when the decision unit decides the
product ID included in the product information is registered

again in the product information registration unit during the
designated temporary registration period as taught by Carey
because this would provide a manner in which to track product
registrations, thus aiding the client by reducing fraud and
errors which may increase the cost to the client.

Referring to claim 18:

Highbloom discloses

a registration migration unit that decides whether or not
the product ID included in the acquired product information
registered in the temporary registration unit is registered in
the product information registration unit by referring to the
product information registration unit (col. 7, lines 35-55; "An
optional third step may be performed which includes comparing
the VIN against a prestored range of valid VIN numbers provided
by the manufacturers. If the VIN passes all of the provided
steps, the record 38 or 40 is entered into the memory 26 of the
monitoring computer 12 for subsequent data comparisons by the
data comparator 28.", and

Carey teaches

that migrates the product information from the temporary
registration unit to the product information registration unit
when the product ID included in the product information is
registered in the product information registration unit (pages

56, 103-108, and 110-111; "You can use a query to add records to
a table by creating an append query").

   Referring to claim 19:

   Carey teaches wherein the registration migration unit
cancels registration of the acquired product information in the
temporary registration unit when the product ID included in the
acquired product information is not registered in the product
information in a designated temporary registration period (pages
104, 109, and 112; "…you might want to find which records in one
table have no match in the other table" and "If you want to
remove records from a table based on a criterion or criteria,
you can do so with a delete query.").

<div align="center">***Response to Arguments***</div>

7.   Applicant's arguments with respect to claims 14-21 have
been considered but are moot in view of the new ground(s) of
rejection.

<div align="center">***Conclusion***</div>

8.   Applicant's amendment necessitated the new ground(s) of
rejection presented in this Office action. Accordingly, **THIS
ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is
reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

    A shortened statutory period for reply to this final action
is set to expire THREE MONTHS from the mailing date of this
action. In the event a first reply is filed within TWO MONTHS
of the mailing date of this final action and the advisory action
is not mailed until after the end of the THREE-MONTH shortened
statutory period, then the shortened statutory period will
expire on the date the advisory action is mailed, and any
extension fee pursuant to 37 CFR 1.136(a) will be calculated
from the mailing date of the advisory action. In no event,
however, will the statutory period for reply expire later than
SIX MONTHS from the date of this final action.

Contact

    Any inquiry concerning this communication or earlier
communications from the examiner should be directed to CARRIE A.
STRODER whose telephone number is (571)270-7119. The examiner
can normally be reached on Monday - Thursday 8:00 a.m. - 5:00
p.m. ET.

    If attempts to reach the examiner by telephone are
unsuccessful, the examiner's supervisor, Jan Mooneyham can be
reached on (571)272-6805. The fax phone number for the
organization where this application or proceeding is assigned is
571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 3689

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